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EXAMINER	
CASCA, FRED A	

ART UNIT	PAPER NUMBER
2617	

NOTIFICATION DATE	DELIVERY MODE
08/05/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/562,566	CHIPCHASE ET AL.	
	Examiner	Art Unit	
	FRED A. CASCA	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-10 and 50-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-10 and 50-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on July 09, 2010. Claims 1, 3, 4-10 and 50-61 are still pending in the present application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 60-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Specifically, the claims recite a "computer program embodied on a computer-readable storage medium" and not on a "**non-transitory** computer-readable storage medium." When given broadest reasonable interpretation, the claims can be interpreted as encompassing pure signals therefor rendering the claims as a whole non-statutory. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim , 3, 4-10 and 50-61are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley et al (US 6,728,712 B1) in view of Shteyn (US 6,782,253 B1).

Referring to claim 1, Kelley discloses an apparatus (abstract, col. 1, lines 12-20 and figure 1, "client computer", "network server"), the device comprising: at least one processor and at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to store a set of tags (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark", note that bookmarks (tags) are stored in the database 14 of the client computer, thus, the processor and the program code are inherent) and for each tag store an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines 10-11, "web address or URL"); provide a user interface (Fig. 1, "screen", "mouse-controlled curser") that enables a user to select one of the tags and cause the apparatus to initiate a connection to the network address associated with the tag (Col. 1, lines 15-20);

automatically alter the network address associated with the tag in response to a communication received from the network (Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered).

Kelley further discloses the apparatus is capable of communicating with the network to request the network to transmit a communication automatically altering the network address associated with a tag (Kelley, Col. 1, lines 40-50 and col. 3, lines 50-65).

Kelley does not specifically disclose estimate the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network in the format claimed.

In an analogous art, Shteyn discloses a mobile device that comprises estimating the location of the mobile communication device, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network (Figures 1-6 and Col. 1, lines 39-62, Col. 2, lines 6-28 and lines 47-56, Col. 3, lines 1-15 and Col. 4, lines 17-45).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the invention of Kelly such that the apparatus of Kelley would be able to estimate its location, for the purpose of letting the network informed of its location, and consequently allowing the network to alter the network address associated with the tag and thus providing proper services to the user.

Referring to claim 3, the combo of Kelley/Shteyn discloses the apparatus in claim 1 and further discloses the user interface having a mode where a user can cause the mobile apparatus to transmit the said communication with the network to request transmission of the communication automatically altering the network address associated with the tag (Kelley, Col. 1, lines 46-50).

Referring to claim 4, the combo of Kelley/Shteyn discloses the apparatus as claimed in claim 3 and further discloses device is arranged to transmit the said communication automatically (Kelley, Col. 1, lines 43-45).

Referring to claim 5, the combo of Kelley/Shteyn discloses the apparatus as claimed in claim 4, and further disclose the device being arranged to detect a service provider of the network (Kelley, inherent e.g., by selecting a bookmark) to which it is connecting, and to transmit said communication in response to a change in the service provider (Kelley, Col. 1, lines 43-45).

Referring to claim 6, the combination of Kelley/Shteyn discloses the apparatus as claimed in claim 1 and further discloses that the tags and their associated network addresses are stored in a database (Kelley, Figure 1 and Col. 4, lines 1-15 and the rejection of claim 1 above).

The combination is silent on whether the tags and their associated network addresses being stored in a dynamic service card as claimed.

It would have been an obvious design choice to modify the combination of Kellely/Green such that the tags and their associated network addresses would be stored in dynamic service card since the applicant has not indicated that storing the tags and associated addresses in the

dynamic service card would solve any stated problem or is for any particular purposes and it appears that having the tags and associated addresses stored in the database of Kelley would perform equally well.

Referring to claim 7, the combo of Kelley/Shteyn discloses the apparatus as in claim 1, and further discloses the network address associated with the tag comprising at least one of: a telephone number; an email address; an uniform resource locator (Kelley, Col. 1, lines 12-15, "URL").

Referring to claim 8, is analogous the features of claim 1. Thus, it is rejected for the same reasons as set forth above in the rejection of claim 1.

Referring to claim 9, the combination of Kelley/Shteyn discloses the apparatus as claimed in claim 8, and further discloses the at least one instruction instructs the mobile communication device to automatically alter the network address associated with a tag stored in the mobile communication device to the network address associated with a tag stored in the network means (Kelley, Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered).

Claim 10 recites features analogous to the features of claim 1. Thus, it is rejected for the same reasons as set forth above in the rejection of claim 1.

Referring to claim 50, Kelley discloses a method (abstract, col. 1, lines 12-20 and figure 1, "client computer", "network server"), comprising: storing a set of tags and for each tag,

storing an associated network address; providing a user interface that enables a user to select one of the tags and cause a mobile communication terminal to initiate a connection to the network address associated with the tag (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark", note that bookmarks (tags) are stored in the database 14 of the client compute); communicating with the network to request that the network transmit a communication that automatically alters the network address associated with a tag (Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered) and automatically altering the network address associated with the tag in response to the communication received from the network (Kelley, Col. 1, lines 40-50 and col. 3, lines 50-65).

Kelley does not specifically disclose estimating the location of the mobile communication terminal; and in dependence on the estimated location altering the tag address in the format claimed.

In an analogous art, Shteyn discloses estimating the location of the mobile communication terminal; and in dependence on the estimated location altering the tag address (Figures 1-6 and Col. 1, lines 39-62, Col. 2, lines 6-28 and lines 47-56, Col. 3, lines 1-15 and Col. 4, lines 17-45).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the above combination such that the apparatus of Kelley would be able to estimate its location, for the purpose of letting the network informed of its location, and consequently allowing the network to alter the network address associated with the tag and thus providing a efficient service providing system and convenience to the user.

Referring to claim 51, the combination of Kelley/Shteyn discloses a method as claimed in claim 50, and further disclose comprising estimating the location of the mobile communication terminal, wherein the mobile communication terminal is configured to communicate with the network to request the network to transmit a communication automatically altering the network address associated with a tag in dependence on the location estimated by the mobile communication terminal (Kelley, Col. 1, lines 40-50 and col. 3, lines 50-65, and Green Par. 19).

Referring to claim 52, the combination of Kelley/Shteyn discloses the method as claimed in claim 51, and further disclose the user interface has a mode where a user can cause the apparatus to communicate with the network to request transmission of the communication automatically altering the network address associated with the tag (Figures 1-2, "screen").

Referring to claim 53, . the combination of Kelley/Shteyn discloses the method as claimed in claim 52, wherein the mobile communication terminal communicates with the network automatically (Kelley, Fig. 1-2 and Col. 1, lines 40-50 and col. 3, lines 50-65).

Referring to claim 54, the combination of Kelley/Shteyn discloses the method as claimed in claim 53, further comprising: detecting a service provider of the network to which the mobile

communication terminal is connecting, and to communicate with the network in response to a change in the service provider (Kelley, Fig. 4 and Col. 3, lines 11-65).

Referring to claim 55, combination of Kelley/Shteyn discloses the method as claimed in claim 50, and further disclose tag and its associated network address are stored as a dynamic service card (see the rejection of claim 1 above).

Claim 56 is analogous to the features of claim 7. Thus, it is rejected for the same reasons as set forth above.

Referring to claim 57, Kelley discloses a method (abstract and Figures 2-4), comprising: storing a set of tags and for each tag, storing an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark"); and communicating at least one instruction containing a tag and an associated network address with at least one mobile communication terminal (Figures 1-4 and Col. 1, lines 15-20), wherein the at least terminal is configured to communicate with a network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page").

Kelley is silent on whether the communication device is a mobile communication device and Kelly is silent on automatically altering the network address associated with a tag in dependence on an estimated location in the format claimed.

Shteyn discloses the communication device as being a mobile communication device and the automatically altering the network address associated with a tag in dependence on an estimated location in the format claimed (Figures 1-6 and Col. 1, lines 39-62, Col. 2, lines 6-28 and lines 47-56, Col. 3, lines 1-15 and Col. 4, lines 17-45).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the invention of Kelly such that the apparatus of Kelley would be able to estimate its location, for the purpose of letting the network informed of its location, and consequently allowing the network to alter the network address associated with the tag and thus providing an efficient service providing system and convenience to the user.

Referring to claim 58, the combination of Kelley/Shteyn discloses the method as claimed in claim 57, wherein the at least one instruction instructs the mobile communication terminal to automatically alter a network address associated with a tag stored in the mobile communication terminal to the network address associated with a tag stored in a network element (Shteyn, Figures 1-6 and Col. 1, lines 39-62, Col. 2, lines 6-28 and lines 47-56, Col. 3, lines 1-15 and Col. 4, lines 17-45).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the invention of Kelly such that the apparatus of Kelley would be able to estimate its location, for the purpose of letting the network informed of its location, and consequently

allowing the network to alter the network address associated with the tag and thus providing an efficient service providing system and convenience to the user.

Referring to claim 59, the combination of Kelley/Shteyn discloses the method as claimed in claim 57, further comprising: storing a list of associated tags for one or more of the at least one mobile communication terminal, and instructing the one or more of the at least one mobile communication terminal only to alter the network addresses associated with the tags associated with the mobile communication terminal identified in the list (Kelley, Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark" and Shteyn, Figures 1-6 and Col. 1, lines 39-62, Col. 2, lines 6-28 and lines 47-56, Col. 3, lines 1-15 and Col. 4, lines 17-45).

Referring to claim 61, claim 61 recites features analogous to the features of claim 57, thus it is rejected for the same reasons as set forth above.

Referring to claim 60, Kelley discloses a computer program embodied on a computer-readable storage medium, the program configured to control a processor (abstract, figures 1-4 and col. 1, lines 12-20 and figure 1, "client computer", "network server") to: store a set of tags and for each tag, store an associated network address; provide a user interface that enables a user to select one of the tags and cause a mobile communication terminal to initiate a connection to the network address associated with the tag (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be

converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark");

communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag (Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered)

Kelley further discloses the apparatus is capable of communicating with the network to request the network to transmit a communication automatically altering the network address associated with a tag (Kelley, Col. 1, lines 40-50 and col. 3, lines 50-65).

Kelley does not specifically disclose the communication device as being a mobile communication device and Kelly is silent on estimating the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tar in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network in the format claimed.

Shteyn disclose the communication device as being a mobile communication device and Kelly is silent on estimating the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tar in

dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the (Figures 1-6 and Col. 1, lines 39-62, Col. 2, lines 6-28 and lines 47-56, Col. 3, lines 1-15 and Col. 4, lines 17-45).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the invention of Kelly such that the apparatus of Kelley would be able to estimate its location, for the purpose of letting the network informed of its location, and consequently allowing the network to alter the network address associated with the tag and thus providing an efficient service providing system and convenience to the user.

Response to Arguments

6. Applicant's arguments with respect to the rejection of claims 1, 3, 4-10 and 50-61 under U.S.C 103(a) have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments with respect to the rejection of claims 60-61 under U.S.C 101 have been considered but they are not persuasive. The examiner asserts that the rejection of claims 60-61 is based on the fact that a "storage medium" could include a transitory signal. Accordingly, the claims can be interpreted as encompassing pure signals and thus rendering the claims as a whole non-statutory. The examiner suggests inserting the phrase "non-transitory" before the phrase "computer-readable storage medium."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred A. Casca/

Examiner, Art Unit 2617

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617